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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,008	01/11/2002	Reed J. Blau	1082-035	5219

33461 7590 03/14/2003

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EXAMINER	
MILLER, EDWARD A	
ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application N .	Applicant(s)	
	10/046,008	BLAU, REED J.	
	Examin r	Art Unit	
	Edward A. Miller	3641	

-- The MAILING DATE of this communication appears on the cov r sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-65* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25, drawn to a first propellant, classified in class 149, subclass 46.

II. Claims 26-51, drawn to a second propellant, classified in class 149, subclass 76.

III. Claims 52-58, drawn to a first method, classified in class 149, subclass 109.6.

IV. Claims 59-65, drawn to a second method, classified in class 149, subclass 109.6.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions III or IV, and I or II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the respective products of Groups I and II may be made by different methods different than in Groups III and IV, such as by merely mixing the respective ingredients to form a composition.

4. While Group III can be used to make Group I, and Group IV can be used to make Group II as set forth above, the respective Group I and II products are not made by the other of the Group III and IV methods, as claimed, so Groups I and IV, on the one hand, and Groups II and III, on the other, are independent. Likewise, Groups I and II, as well as Groups III and IV, are independent as claimed. To the extent that there may be a subcombination common to Both Groups I and II, this does not join the respective Groups. See MPEP 806.04(c), "Subcombination Not Generic to Combination," in part:

> The situation is frequently presented where two different combinations are disclosed, having a subcombination common to each. It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto. This was recognized in Ex parte Smith, 1888 C.D. 131, 44 O.G.1183 (Comm'r Pat. 1888), where it was held that a subcombination was not generic to the different combinations in which it was used.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Further, these inventions are distinct for the reasons given above and the search required for Groups III and IV respectively differ. Thus restriction for examination purposes as indicated is proper. This is due to the different limitations for these methods, since the Group III invention with nitric acid processing requires search, for example, in class 149/46, while the Group IV invention with perchloric acid processing requires search, for example, in class 149/76.

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of composition, or composition made, for examination purposes, even though this requirement is traversed and regardless of which Group above is elected. The single species shall be a single example of the composition (made), with each ingredient thereof particularly specified. Related search is required in many subclasses of class 149, depending on these details, and thus this requirement is based upon PTO policy for undue breadth, and or Markush terminology, MPEP 809.02(d) and 803.02. It is not clear what claims are generic, because of the potential overlap among the Groups I and II inventions depending on optional claimed ingredients. As currently written, the first claim of each of Groups I and II is not generic to the other Group; there is no overlap.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious

variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. New, corrected drawings are required in this application because of 37 CFR 1.85(a). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance. See form PTO 948.

8. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
March 12, 2003

EDWARD A. MILL
PRIMARY EXAMI